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EXAMINER
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NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2454

NOTIFICATION DATE	DELIVERY MODE
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03/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/816,428	<b>Applicant(s)</b> BUCHHEIT ET AL.	
	<b>Examiner</b> DUSTIN NGUYEN	<b>Art Unit</b> 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 82-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 82-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 82-118 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/08/2010 has been entered.

#### ***37 CFR 1.131 Affidavit***

3. The affidavit filed on 02/08/2010 under 37 CFR 1.131 with the intention to show the reduce to practice as early as 06/22/2002 has been considered but is ineffective to overcome the Woody et al. reference (U.S. Patent Application No. 2005/0144157) for the following reasons:

##### **Regarding Reduction to Practice:**

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." **In re Asahi /America Inc.**, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir.1995)

(Citing **Newkirk v. Lulejian**, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and **Sachs v. Wadsworth**, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). **In re Borkowski**, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also **In re Harry**, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”) [see **MPEP 715.07**].

“The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention.” **Gellert v. Wanberg**, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) (“an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests”); **Wells v. Fremont**, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) (“even where tests are conducted under bench’ or laboratory conditions, those conditions must fully duplicate each and every condition of actual use’ or if they do not, then the evidence must establish a relationship between the

subject matter, the test condition and the intended functional setting of the invention,” but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water) [see **MPEP 2138.05**].

Applicant has provided some screenshots (exhibits A and B) to indicate that the invention was actually reduced to practice. However, the examiner respectfully submits that it is not clear how the screenshots (exhibits A and B) are specifically teaching applicant's claimed invention. There is no discussion of claims as they relate to the evidence (exhibits A and B) provided and how the limitations of those claims find support in the evidence provided.

For example, claim 1 recites “responding to receipt of a query from a requestor, the query having one or more query terms, including: transmitting the query over a network to a conversation management system; receiving from the conversation management system a list of conversations that match the one or more query terms, each of the conversations in the list having a respective conversation identifier, and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria and at least one conversation in the list of conversations comprises a plurality of messages; and presenting at least a portion of the list of conversations to the requestor, each conversation listed in the presented portion of the list being represented as a single item, the presented portion of the list including a plurality of items, each representing a distinct conversation, at least one of which comprises a plurality of messages, wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation.” There is no clear explanation of the relationship between the claimed limitations and evidence (exhibits A and B) provided.

In addition, it does not appear that the invention was reduced to practice as of the filing date of the Woody reference. Applicants must then show due diligence from before the Woody reference until an actual reduction to practice or constructive reduction to practice. In this case, applicant has failed to provide this evidence to establish diligence from a date prior to the date of reduction to practice of the Woody reference to either a constructive reduction to practice or an actual reduction to practice.

Thus, the affidavit filed on 02/08/2010 is deemed insufficient to remove Woody reference as prior art.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 82-118 are provisional rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Application No. 10/941014 [ hereinafter as '014 application ] and U.S. Patent Application No

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10/941035 [ hereinafter as '035 application ]. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter.

The claims of '014 and '035 applications contain every element of claims 82-118 of the instant application and thus anticipated the claims of the instant application. Claims of the instant application therefore are not patentably distinct from the earlier patent claims and as such is unpatentable over obvious-type double patenting. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (Decided: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)(holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor had held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. According, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting."(In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

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would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 82, 84-88, 91-95, 98-100, 102-104, 107-111 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ].

7. As per claim 82, Moody discloses the invention as claimed including a method for searching messages in a conversation-based message system [ i.e. system and method for searching and retrieving related messages ] [ Figure 5; and Abstract ], comprising:

at a client having one or more processors and memory storing programs executed by the one or more processors, responding to receipt of a query from a requestor, the query having one or more query terms [ i.e. search module provides the user with a query box in which the user may enter one or more search terms ] [ Figure 5; and paragraphs 0009-0012, 0053 and 0054 ], including:

transmitting the query over a network to a conversation management system [ i.e. search module accesses threading service 110 ] [ 108, 100, Figure 1; and paragraphs 0024, 0026, 0053 and 0057 ];

receiving from the conversation management system a list of conversations that match the one or more query terms [ i.e. a list of messages related to the particular message from threading service 110 ] [ paragraphs 0057 and 0064 ], and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria [ i.e. match user query as well as a set of messages related thereto ] [ paragraphs 0006 and 0057 ]



] and at least one conversation in the list of conversations comprises a plurality of messages [ i.e. list of related messages may include the matching message and all message in the same thread ] [ paragraph 0057 ]; and

presenting at least a portion of the list of conversations to the requestor [ i.e. display the search results in various ways ] [ paragraphs 0012, 0058-0060 ], each conversation listed in the presented portion of the list being represented as a single item [ paragraphs 0014, 0015, 0059 and 0060 ].

Moody does not specifically disclose each of the conversations in the list having a respective conversation identifier, and the presented portion of the list including a plurality of items, each representing a distinct conversation, at least one of which comprises a plurality of messages, wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation.

Doherty discloses

each of the conversations in the list having a respective conversation identifier [ i.e. identified conversations ] [ Figure 6A; and paragraphs 0034, 0036 and 0077 ], and the presented portion of the list including a plurality of items, each representing a distinct conversation, at least one of which comprises a plurality of messages, wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation [ i.e. display post counts or conversation counts ] [ Figure 11; and paragraphs 0073, 0077, 0103 and 0160 ].

It would have been obvious to a person skill in the art at the time the invention was made to incorporate the teaching of Doherty to the system of Moody since it would enable to

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quantitatively assess the communication capabilities of individuals of various individuals participating in electronic environment [ Doherty, paragraph 0013 ].

8. As per claim 84, Moody discloses wherein the conversations are presented to the requestor in an order determined in accordance with a date/time value of a most recently received message of each respective conversation in the presented portion of the list [ i.e. display the search results in the order of date ] [ paragraphs 0013, 0058-0060 ].

9. As per claim 85, Moody discloses wherein the conversations are presented to the requestor in an order determined in accordance with, for each respective conversation in the presented portion of the list, a date/time value of a most recently received message that is relevant to the search query [ i.e. display the search results in the order of relevance ] [ paragraphs 0013, 0058-0060 ].

10. As per claim 86, it is rejected for similar reasons as stated above in claim 82. Furthermore, Doherty discloses at a server: receiving a plurality of messages directed to a user [ paragraphs 0066-0070 ], each message having a unique message identifier; generating a plurality of conversations [ Abstract; and paragraphs 0015 and 0077 ], generating a plurality of conversations, each conversation including a respective conversation identifier and unique subset of the plurality of messages [ paragraphs 0034 and 0069 ].

11. As per claim 87, Doherty discloses wherein the respective conversation identifier is

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distinct from a subject reference of the message [ 110, Figure 6A ].

13. As per claim 88, Doherty discloses wherein the respective conversation identifier is based in part on information not including a subject reference of the message [ Figure 6A; and paragraphs 0082 and 0085 ].

14. As per claim 91, Moody discloses wherein the two or more electronic messages in a conversation have substantially the same subject reference of the messages and at least one characteristic of the messages other than the subject reference [ i.e. construct item of dynamic interest profile ] [ Figure 6; Abstract; and paragraphs 0061-0065 ].

15. As per claim 92, it is rejected for similar reasons as stated above in claim 85.

16. As per claims 93-95, they are rejected for similar reasons as stated above in claims 86-88.

17. As per claim 98, it is rejected for similar reasons as stated above in claim 91.

18. As per claim 99, it is rejected for similar reasons as stated above in claim 85.

19. As per claim 100, it is rejected for similar reasons as stated above in claim 82.

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20. As per claims 102-104, they are rejected for similar reasons as stated above in claims 86-88.

21. As per claim 107, it is rejected for similar reasons as stated above in claim 91.

22. As per claim 108, it is rejected for similar reasons as stated above in claim 85.

23. As per claims 109, 111 and 118, they are rejected for similar reasons as stated above in claim 82.

24. Claims 83, 89, 96, 101, 105, 110, and 112-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ], and further in view of Rohall et al. [ US Patent Application No 2003/0163537 ].

25. As per claim 83, Moody and Doherty do not specifically disclose wherein the single item for a respective conversation in the presented portion of the list of conversation is generated so as to include a text string having a highlighted instance of at least one of the one or more query terms. Rohall discloses wherein the single item for a respective conversation in the presented portion of the list of conversation is generated so as to include a text string having a highlighted instance of at least one of the one or more query terms [ i.e. highlight message ] [ paragraphs

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0066, 0070, 0071, 0075 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Moody, Doherty and Rohall because the teaching of Rohall would enable to provide an effectively reviewing and processing electronic mail and electronic mail threads [ Rohall, paragraph 0005 ]

26. As per claim 89, it is rejected for similar reasons as stated above in claim 83.

27. As per claim 96, it is rejected for similar reasons as stated above in claim 83.

28. As per claim 101, it is rejected for similar reasons as stated above in claim 83.

29. As per claim 105, it is rejected for similar reasons as stated above in claim 83.

30. As per claim 110, it is rejected for similar reasons as stated above in claim 83.

31. As per claims 112-117, they are rejected for similar reasons as stated above in claim 83.

Furthermore, Doherty discloses wherein the single item for a respective conversation in the presented portion of the list includes a subject of the respective conversation [ 110, Figure 6A; and paragraphs 0012, 0064, 0176 ].

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32. Claims 90, 97, 106 rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ], and further in view of Douglas E. Comer and Larry L. Peterson, “Conversation-Based Mail” [ hereinafter as Comer ].

33. As per claim 90, Moody and Doherty do not specifically disclose wherein at least one of the conversations comprises a plurality of electronic messages having a close temporal relationship with each other. Comer discloses wherein at least one of the conversations comprises a plurality of electronic messages having a close temporal relationship with each other [ page 8, lines 19-35 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Moody, Doherty and Comer because the teaching of Comer would enable to provide tools to organizing the message presented to the user, archiving message for future reference, and reducing the volume of messages [ Comer, page 301, paragraphs 4-7 ].

34. As per claim 97, it is rejected for similar reasons as stated above in claim 90.

35. As per claim 106, it is rejected for similar reasons as stated above in claim 90.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/  
Primary Examiner, Art Unit 2454